



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/905,449	07/13/2001	Avi Ashkenazi	10466/58	1667	
9157	7590 06/29/2004		EXAMINER		
GENENTECH, INC.			MOSHER, MARY		
1 DNA WAY SOUTH SAN FRANCISCO, CA 94080			ART UNIT	PAPER NUMBER	
5001115111	,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,		1648		
			DATE MAILED: 06/29/200	DATE MAILED: 06/29/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No. Office Action Summary						
Examiner Mary E. Mosher, Ph.D.						
Mary E. Mosher, Ph.D. 1648 The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. Edensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after Str. (s) MONTHS from the mailing date of this communication. If the period for reply specified above the mailing date of this communication. Failure to reply within the active the mailing date of this communication. Failure to reply within the active that there months after the mailing date of this communication. Explication to become ABANCONED (S) U.S. C, § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any carmed patent term adjustment. See 37 CFR 1.704(b). Status 1) □ Responsive to communication(s) filed on 12 April 2004. 2a) □ This action is FINAL. 2b) □ This action is non-final. 3) □ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) □ Claim(s) 44-46 and 49-51 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5□ Claim(s) is/are allowed. 6) □ Claim(s) is/are objected to. 8) □ The specification is objected to by the Examiner. 10) □ The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to See 37 CFR 1.85(a). Priority under 35 U.S.C. § 1						
- The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after Stz (6 MONTHS from the mailing date of this communication. I NO period for reply with the search of the standard property with the standard process (8 MONTHS from the mailing date of this communication. Failure to reply within the set or decended pend for reply wit, by standard or reply wit, by standard or reply with possible of this communication. Failure to reply within the set or decended pend for reply wit, by standard or reply with possible of the scormonard part of the mailing date of this communication, even if timely filed, may reduce any carmed patent term adjustment. See 37 CFR 1.704(b). Status 1) ■ Responsive to communication(s) filed on 12 April 2004. 2a) ■ This action is FINAL. 2b) ■ This action is non-final. 3) ■ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) ■ Claim(s) 44-46 and 49-51 is/are pending in the application. 4a) Of the above claim(s) is/are allowed. 6) ■ Claim(s) is/are allowed. 6) ■ Claim(s) is/are objected to. 8) □ The specification is objected to by the Examiner. 10) □ The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner. Application Papers 9) □ The specification is objected to by the Examiner. 10) □ The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner. Application Papers 9) □ The other drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawi						
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ③ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed aller St. (6) MONTH'S from the mailing date of this communication. - If the period for reply is specified above, the maximum statutory period will apply (6) MONTH'S from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (63 U.S. 5, 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status 1) □ Responsive to communication(s) filed on 12 April 2004. 2a) □ This action is FINAL. 2b) □ This action is non-final. 3) □ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) □ Claim(s) 44-46 and 49-51 is/are pending in the application. 4a) Of the above claim(s) is/are allowed. 6) □ Claim(s) 44-46 and 49-51 is/are rejected. 7) □ Claim(s) is/are allowed. Application Papers 9) □ The specification is objected to by the Examiner. 10) □ The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner. Application Papers Priority under 35 U.S.C. § 119 12) □ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
HE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filled alter SIX (6) MONTHS from the mailing date of this communication. If the period for reply seglided above is best than thinty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. If NO period for reply seglided above is best than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. If NO period for reply seglided above is best than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. If NO period for reply is specified above is best than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. If NO period for reply seglided above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. Failure to reply within the statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. Any reply received by the Office later than three months after the mailing date of this communication, even if timely filled, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status 1) ☐ Responsive to communication(s) filled on 12 April 2004. 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final. 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) ☐ Claim(s) 44-46 and 49-51 is/are pending in the application. 4) ☐ Claim(s) 44-46 and 49-51 is/are pending in the application. 5) ☐ Claim(s) 44-46 and 49-51 is/are rejected. 7) ☐ Claim(s) 44-46 and 49-51 is/are rejected. 8) ☐ Claim(s) 44-46 and 49-51 is/are rejected to by the Examiner. 10) ☐ The drawing(s) filed on is/are a)						
1) ⊠ Responsive to communication(s) filed on 12 April 2004. 2a) ⊠ This action is FINAL. 2b) ☐ This action is non-final. 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) ☒ Claim(s) 44-46 and 49-51 is/are pending in the application. 4a) Of the above claim(s) ☐ is/are withdrawn from consideration. 5) ☐ Claim(s) ☐ is/are allowed. 6) ☒ Claim(s) 44-46 and 49-51 is/are rejected. 7) ☐ Claim(s) ☐ is/are objected to. 8) ☐ Claim(s) ☐ are subject to restriction and/or election requirement. Application Papers 9) ☐ The specification is objected to by the Examiner. 10) ☐ The drawing(s) filed on ☐ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) ☐ All b) ☐ Some * c) ☐ None of:	on.					
2a) ☐ This action is FINAL. 2b) ☐ This action is non-final. 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) ☐ Claim(s) 44-46 and 49-51 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) is/are objected to. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and/or election requirement. Application Papers 9) ☐ The specification is objected to by the Examiner. 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) ☐ All b) ☐ Some * c) ☐ None of:						
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) Claim(s) 44-46 and 49-51 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) Claim(s) is/are allowed. 6) Claim(s) 44-46 and 49-51 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
Closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) Claim(s) 44-46 and 49-51 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) Claim(s) is/are allowed. 6) Claim(s) 44-46 and 49-51 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
Application Papers 9) The specification is objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.121(d 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) Claim(s) 44-46 and 49-51 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) Claim(s) is/are allowed. 6) Claim(s) 44-46 and 49-51 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. Application Papers 9) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Application Papers 9) The specification is objected to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d) 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).	/					
4) Claim(s) 44-46 and 49-51 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) Claim(s) is/are allowed. 6) Claim(s) 44-46 and 49-51 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d) 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.					
4a) Of the above claim(s) is/are withdrawn from consideration. 5) □ Claim(s) is/are allowed. 6) ☒ Claim(s) 44-46 and 49-51 is/are rejected. 7) □ Claim(s) is/are objected to. 8) □ Claim(s) are subject to restriction and/or election requirement. Application Papers 9) □ The specification is objected to by the Examiner. 10) □ The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) □ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) □ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) □ All b) □ Some * c) □ None of:						
5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) 44-46 and 49-51 is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and/or election requirement. Application Papers 9) ☐ The specification is objected to by the Examiner. 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) ☐ All b) ☐ Some * c) ☐ None of:						
6) Claim(s) 44-46 and 49-51 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:	5) Claim(s) is/are allowed.					
8) Claim(s) are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
Application Papers 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) Some * c) None of:						
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:	9)☐ The specification is objected to by the Examiner.					
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:	10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.					
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:	·					
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
a) ☐ All b) ☐ Some * c) ☐ None of:						
2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.						
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 4) Interview Summary (PTO-413) Paper No(s)/Mail Date 5) Notice of Informal Patent Application (PTO-152) Paper No(s)/Mail Date						

Application/Control Number: 09/905,449

Art Unit: 1648

< 3

DETAILED ACTION

Claim Rejections - 35 USC § 102

Claims 44-46 and 49-51 remain rejected under 35 U.S.C. 102(e) as being anticipated by Lal et al 5,942,606.

The sole issue remaining in this application is whether or not Lal et al is available as prior art, and this issue turns upon whether or not the invention as claimed is enabled by the disclosure in provisional application 60/062,816, filed prior to Lal. The examiner has denied benefit on the grounds that 60/062,816 does not meet the how-to-use requirement of 35 USC 112, first paragraph, because prior to the disclosure of VEGF-inhibitory activity none of the asserted uses could be practiced without undue experimentation.

Applicant maintains that, in the provisional application, the disclosure of structural similarity between the claimed polypeptide and the CAR virus receptor was sufficient to teach one skilled in the art how to use the claimed polypeptide as a novel cell surface virus receptor. The examiner has cited art as evidence that similarity in structure does not equate to similarity in function for a virus receptor. The examiner also pointed out in the office action mailed 10/2/2002 that there was no information regarding what viruses, if any, use the claimed polypeptide as a receptor. Applicant points to the similarity in disclosure between the provisional application and the Lal specification, and argues (1) if the Lal disclosure is presumptively enabling then the provisional disclosure should also be considered enabled, and (2) if the provisional disclosure is not enabling then neither is the Lal disclosure, and enablement is required for anticipation.

Application/Control Number: 09/905,449

Art Unit: 1648

Regarding argument (1), each application is treated on its own merits. In this application, the examiner has provided reasons to reach a prima facie conclusion that, in the provisional application, the disclosure did not meet the how-to-use requirement of 35 USC 112, first paragraph, and applicant has not provided convincing arguments or evidence to overcome that prima facie conclusion.

Regarding argument (2), Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research, 68 USPQ2d 1373, 1376 (CA FC 2003) does quote Bristol-Myers Squibb v. Ben Venue Laboratories, Inc., 246 F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001), stating "To anticipate the reference must also enable one of skill in the art to make and use the claimed invention." However, this passage in Bristol-Meyers appears only in the context of a citation to In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985); Donohue in turn deals exclusively with issues of making the asserted prior art compound. Elan itself also deals with issues whether the asserted prior art teaches how to make the product in question. The cited page of Amgen, Inc. v. Hoechst Marion Roussel, Inc. 65 USPQ2d 1385, 1416 (Fed Cir 2003) states: "Long ago our predecessor court recognized that a non-enabled disclosure cannot be anticipatory (because it is not truly prior art) if that disclosure fails to 'enable one of skill in the art to reduce the disclosed invention to practice.' [citations omitted]." Therefore, the statement that an anticipating reference must teach how to "use the claimed invention" appears to be dicta, not a reversal of In re Schoenwald (22 USPQ2d 1671, Fed Cir 1992).

Application/Control Number: 09/905,449

Art Unit: 1648

, 12

To quote Robert L. Harmon in the reference book <u>Patents and the Federal Circuit</u>, Fifth Edition, (BNA Books, Washington DC, 2001, page 85): "If compositions are known, for any use or no use, they are not patentable as compositions, by force of §102... It is beyond argument that no utility need be disclosed for a reference to be anticipatory of a claim to an old compound." Lal teaches how to make the protein that applicants are claiming, and Lal conveys possession of the protein by disclosing its full structure. Therefore, the disclosure in Lal is sufficient for anticipation, regardless of what Lal may teach or fail to teach about how to use the protein.

Applicant's arguments are unconvincing, and the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1648

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is 571-272-0906. The examiner can normally be reached on M-T and alternate F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/24/04

MARY E. MOSHER PRIMARY EXAMINER GROUP 1800 /600